

REMARKS

I. OVERVIEW

Claims 23-29 will be pending in the present application upon entry of this amendment. Claims 23-27 have been amended. Claims 28 and 29 are newly presented. The issues raised by the Examiner in the Non-Final Office Action of December 20, 2006 (*Office Action*) are as follows:

- The Information Disclosure Statement of April 23, 2004 is listed as failing to comply with 37 C.F.R. § 1.98(a)(2);
- Claims 24-27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; and
- Claims 23-27 rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,336,255 (*Kanare*) in view of U.S. Patent No. 5,160,828 (Olsen).

In response, Applicant respectfully traverses the outstanding claim rejections and requests reconsideration and withdrawal in light of the remarks presented herein.

II. INFORMATION DISCLOSURE STATEMENT

The Information Disclosure Statement (IDS) of April 20, 2004 is listed as failing to comply with 37 C.F.R. § 1.98(a)(2). *Office Action* at p. 2. In that IDS, Applicant stated that:

[t]his application is a application of Serial No. 09/616,769 filed March 24, 1998 and issued as U.S. Patent 6,094,599, and is relied upon for an earlier filing date under 35 U.S.C. § 120. In accordance with Rule 37 C.F.R. § 1.98(d) copies of the listed documents are not enclosed as they have been previously cited by or submitted to the Patent and Trademark Office in prior application Serial No. 09/616,769.

IDS of April 20, 2004 at p. 2. Applicant respectfully notes that, although the correct U.S. Patent number was cited in the above paragraph, it was associated with the wrong application serial number due to an oversight. U.S. Patent No. 6,094,599 in fact corresponds to 03/046,856 (not 09/616,769). Therefore, copies of the documents listed in the IDS of April 20, 2004 have been previously cited by or submitted in connection with application serial no. 03/046,856. Applicant apologizes for the inadvertent mistake. Withdrawal of the objection to the IDS and consideration

of the cited references therein are respectfully requested. If there are any questions or concerns about this issue, the Examiner is cordially invited to contact the undersigned attorney.

III. AMENDMENTS TO THE CLAIMS

Claim 23 has been amended to more clearly recite previously claimed subject matter and to correct minor inadvertent errors. Claims 24-27 have been amended to correct minor inadvertent errors. No new matter has been added as the recited features find ample support in the Specification as originally filed. *E.g.*, *Specification* at p. 13, lns. 7-21. Moreover, these amendments are not intended to narrow the scope of these claims.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 24-27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. *Office Action* at p. 2. Particularly, the Examiner states that “the limitation ‘the device’ . . . is vague and unclear as the independent claim 23 . . . lists multiple devices.” *Id.* In light of the amendments presented herein, however, Applicant believes that the Examiner’s objection is now overcome.

V. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 23-27 rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kanare* in view of *Olsen*. *Office Action* at p. 3. Applicant traverses the rejection and asserts that the claims are allowable, at least, for the reasons stated below.

The Supreme Court in *Graham* stated that:

[u]nder § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . .

Graham v. John Deere, 383 U.S. 1, 17-18 (1966). In this case, Applicant asserts that the rejection of record should be withdrawn because there are significant differences between the references relied upon by the Examiner and the claims at issue, and because the Examiner has not provided a proper reason why a person of ordinary skill in the art would have combined elements of those references in the manner claimed. *KSR v. Teleflex*, slip op. at p. 14.

A. Differences Between the References and the Claims at Issue

Claim 23, as amended, recites a method comprising: “activating the RF coil in a warming step to warm a patient's body part and to increase blood circulation therein . . . [and] activating the plurality electrodes in a muscle stimulation step to stimulate contraction of the muscles of the patient's body part to increase oxygen delivery and circulation of blood.” The Examiner has previously relied solely upon *Kanare*'s electrodes as meeting the claimed electrodes. *Office Action* at p. 3. However, as the Examiner correctly states, *Kanare*'s electrodes are only operable to heat an injured area. *See, e.g., Kanare* at col. 1, lns. 4-20. Applicant respectfully asserts that *Kanare*'s electrodes do not stimulate muscle contraction. Therefore, *Kanare* does not teach or suggest the step of activating electrodes to stimulate muscle contraction. In addition, Applicant respectfully notes that the Examiner may have improperly treated claim 23 as being an apparatus claim without considering the method steps recited in that claim. *See Office Action* at p. 3.

Dependent claims 24-27 depend from claim 23, thus inheriting all the limitations of that independent claim. As noted above, the combination of *Kanare* with *Olsen* fails to teach or suggest all of the limitations of independent claim 23. Consequently, the combination of *Kanare* with *Olsen* also fails to teach or suggest all of the limitations of dependent claims 24-27. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 23-27.

B. Improper Reason to Combine

Applicant asserts that claims 23-27 are patentable because the combination of *Kanare* with *Olsen* is improper. Particularly, the Examiner states that:

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electrical stimulation heat pack as taught by *Kanare* with RF warming as

taught by *Olsen*, since it is known in the art that RF warming is a suitable and popular way to warm tissue.

Office Action at pp. 3 and 4. First, Applicant respectfully submits that the Examiner's conclusion does not logically follow. *Kanare* already teaches a method for warming tissue, and there is no indication that *Kanare*'s method is unsatisfactory for its intended purpose. The fact that RF warming may be "a suitable and popular way to warm tissue" does not explain why a person of ordinary skill in the art would be motivated to incorporate "RF warming" into *Kanare*'s method, which is itself warming. Applicant respectfully asserts that a person of ordinary skill in the art would not "add" *Olsen* into *Kanare* because *Kanare* already provides a satisfactory warming system.

Perhaps more importantly, Applicant points out that if the proposed modification would render the reference being modified unsatisfactory for its intended purpose, then there is no motivation to make the proposed modification. M.P.E.P. § 2143.01. In this case, the apparatus of *Kanare* cannot be satisfactorily combined with the device shown in *Olsen*. Particularly, Applicant submits that the presence of *Kanare*'s wire stimulator electrode connections prohibit the use of *Olsen*'s resonant-coil RF warming system because of the a strong energy coupling that would result between the two electrical systems.

Therefore, the combination of *Olsen* with *Kanare* is improper. Accordingly, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of record with respect to claims 23-27.

VI. NEW CLAIMS

Claims 28 and 29 are newly presented. No new matter has been added, and Applicant believes that these claims are in immediate condition for allowance in view of the references of record. For example, claim 28 recites "a method of medical treatment in accordance with claim 23, wherein the muscle stimulation step is performed after the warming step." Applicant also asserts that neither *Kanare* nor *Olsen*, taken alone or in combination, teaches or suggests the aforementioned steps in the particular order being claimed. And, as explained in the Specification, the claimed order of treatment itself has patentable significance:

Because of the consequential increased oxygen and blood perfusion, the RF heating better prepares the muscle for muscular contraction, and makes it less likely that the muscle contractions will cause soreness, cramping or irritation. *Thus, the RF heating before the muscular stimulation enhances the safety of this treatment, which is an especially important feature because the subjects of this treatment are often elderly or have severe muscular atrophy.*

Specification at p. 13, lns. 15-21 (emphasis added).

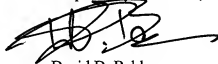
In addition, claim 29 recites “a method of medical treatment in accordance with claim 23, wherein the warming step is performed after the muscle stimulation step.” Similarly as described above with respect to claim 28, neither *Kanare* nor *Olsen*, taken alone or in combination, teaches or suggests the aforementioned steps in the particular order being claimed in claim 29. As, as a person of ordinary skill in the art would recognize in light of the *Specification*, diabetic neuropathy treatments may be advantageously administered by providing muscle stimulation first in order to increase blood flow and/or oxygen perfusion to nerve capillaries thereby improving nerve conduction. See *Specification* at p. 15, ln. 9—p. 17, ln. 4. After the muscle stimulation would come the RF heating to vasodilate the vessels in deep muscle tissue and further increase BF and oxygen perfusion of nerve tissue. *Id.*

Therefore, the combination of *Kanare* with *Olsen* fails to teach or suggest all of the elements of dependent claims 28 and 29. Accordingly, Applicant respectfully requests that the Examiner allow claims 28 and 29.

VII. CONCLUSION

Applicant respectfully submits that the present application is in immediate condition for allowance. If there are any questions or concerns, the Examiner is cordially invited to contact the undersigned attorney at 512-536-3005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D.D. Bahler', with a long horizontal flourish extending to the right.

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